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10/018,177	12/12/2001	Hans-Detlef Arntz	Mo-6837/LcA 33,565	8533

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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/018,177
Filing Date: December 12, 2001
Appellant(s): ARNTZ ET AL.

Lyndanne M. Whalen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 19, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 11-22 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

U.S. 4,124,572	Mao	11-1978

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12, 13, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Adequate support has not been provided for the amendment to claim 12 specifying the sum of the mole percents. Despite appellants' remarks, there is no requirement set forth for the disclosed listing of reactants that requires the sum of the mole percents to total 100 percent, especially when other components are not excluded.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11, 15, 17-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mao ('572).

Patentee discloses the production of flexible polyurethanes, suitable for use in coating, automotive, and fabric coating applications, wherein the polyurethane is produced from a 70:30 to 90:10 weight ratio blend of 1,000-3,000 molecular weight polyether polyol and 1,000-3,000

molecular weight polyester polyol. See columns 2 and 3 and examples. Patentee discloses an index ratio that anticipates appellants' claimed ratio. See column3, lines 53-58 and column 4, lines 54 and 55. Since the disclosed polyurethanes and claimed compositions are produced from equivalent reactants in overlapping ratios, the position is taken that it is logical to conclude that the disclosed polyurethanes inherently possess the same properties [i.e.; oil and petroleum resistance (claims 11 and 17), transparency (claim 18), and hydrolysis and microbial action resistance (claim 19)] as the claimed polyurethanes.

Appellants' argument that Mao does not require the specific types of polyester polyols required in appellants' claims is without merit, because the argument is not commensurate in scope with the claims. The rejected claims do not require the specific polyester polyols argued by appellants.

Appellants' argument that the examples relied upon by the examiner utilize a ratio of isocyanate groups to hydroxyl groups that is much higher than the index ratio claimed (6.0 or 4.5 as opposed to 0.7 – 1.30) is without merit. The index values cited by appellants do not allow for the chain extender component. When the chain extender is allowed for, the index ratio becomes 1; see column 4, line 56.

Appellants' argument bridging pages 4 and 5 of the appeal brief regarding the claimed index range is immaterial. The argument in no way refutes the issue of anticipation.

Appellants' argument pertaining to the quantity of chain extender is without merit; the argument is not commensurate in scope with the claims, because the claims do not limit the quantity of chain extender.

Appellants' argument with respect to the quantity of polyester polyol is not found persuasive in view of the fact that the cited examples utilize quantities of polyester polyol that closely parallel the instantly claimed quantities.

Claims 14, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mao ('572).

As aforementioned, Mao discloses the production of polyurethanes, suitable for the production of coatings and moldings, comprising reactants which meet those claimed by applicants; however, Mao is silent regarding the use of the polyurethanes to produce shoe soles and tubing. Still, the position is taken that the production of both shoe soles and tubing from moldable polyurethanes was well known at the time of invention; therefore, the position is further taken that it would have been obvious to produce such conventional articles from the disclosed polyurethane compositions. Furthermore, though Mao is silent regarding the initial combination of the polyester component with the polyisocyanate, the position is taken that it would have been obvious to create an initial admixture of polyisocyanate and one of the polyol components, so as to compatibilize the polyisocyanate within the composition, by such means as prepolymerization, or to control compatibility problems that could arise from admixing the respective polyol species.

Despite appellants' arguments, the position is maintained that the examiner has set forth a reasonable rationale as to why the subject matter of the claims is considered to be obvious.

(11) Response to Argument

Appellants' arguments have been addressed within the ***Grounds of Rejection***.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rabon Sergent
Primary Examiner
Art Unit 1711

R. Sergent
August 23, 2004

Conferees

Supervisory Patent Examiner James Seidleck

Supervisory Patent Examiner David Wu

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